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Filing date: **08/24/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77626778
Applicant	LaPolla Industries, Inc.
Applied for Mark	THERM-O-FLEX
Correspondence Address	DANIEL S POLLEY DANIEL S POLLEY PA 7251 WEST PALMETTO PARK ROAD, SUITE 202 BOCA RATON, FL 33433 UNITED STATES betty@danpolley.com, dan@danpolley.com
Submission	Applicants Request for Remand and Amendment
Attachments	7009THERM-O-FLEX Request for Remand 8-24-2013.pdf(488885 bytes)
Filer's Name	Daniel S. Polley
Filer's e-mail	dan@danpolley.com
Signature	/Daniel S. Polley/
Date	08/24/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re application of : LaPolla Industries, Inc.
Serial No. : 77/626,778
Filed : December 4, 2008
Mark : **THERM-O-FLEX**
Trademark Attorney : John M. Kelly
Law Office : 117
Our File No. : 1127.7009

CERTIFICATE OF MAILING

I hereby certify that this correspondence, and any attachments thereto, is being electronically filed with the TTAB.

<u>Daniel S. Polley</u> Name of Person Mailing Paper	<u>/Daniel S. Polley/</u> Signature	<u>August 24, 2013</u> Date
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**REQUEST FOR REMAND AND AMENDMENT TO CURRENT
IDENTIFICATION OF GOODS**

Mail Stop TTAB
Commissioner for Trademarks

Dear Sir:

Pursuant to TBMP §1209.04, Applicant respectfully requests remand of the above-identified application to the Examining Attorney and in support thereof respectfully states:

1. Registration of the above-identified mark was refused under Section 2(d) by the Examining Attorney in view of U.S. Registration No. 2,814,821 (“the ‘821 Registration”) for the mark THERMAFLEX owned by Emseal Joint Systems, LTD (“Emseal”).
2. Applicant filed an Appeal of the Examining Attorney’s refusal to register on April 26, 2010.
3. Applicant filed a Petition of Partial Cancellation of the ‘821 Registration which was assigned Cancellation Proceeding No. 92054089.
4. In view of the Cancellation Proceeding, Applicant filed a Motion to Suspend

the appeal in this application on June 10, 2011 and this appeal was suspended by the Board on June 14, 2011.

5. Applicant has now entered into a Consent and Co-Existence Agreement (“Agreement”) with Emseal the owner of the ‘821 Registration. The Agreement is attached hereto as Exhibit A.
6. The Agreement was signed by Emseal on August 16, 2013 and by Applicant on August 21, 2013. As such, the Agreement was not available for the Examining Attorney’s consideration prior to the filing of the instant Appeal. Applicant also respectfully submits that the evidence represented by the Agreement is not cumulative in nature to any evidence already of record.
7. It is also noted that TBMP §1207.02 specifically states that “because a consent agreement offered in response to a refusal to register...may be highly persuasive of registrability, the Board will grant a request to suspend and remand for consideration of a consent agreement if the request, accompanied by the consent agreement, is filed at any time prior to the rendering of the Board’s final decision on the appeal.”
8. Applicant respectfully submits that the Agreement evidences that there is no likelihood of confusion between Applicant’s mark and the mark shown in the ‘821 Registration and that the current Section 2(d) refusal based on the ‘821 Registration should be withdrawn.
9. Thus, in view of the Agreement, Applicant is seeking remand of the above-identified application so that the Examining Attorney can consider the Agreement. 37 C.F.R. §2.142(d); TBMP §1207.02.
10. Applicant’s current identification of goods for the above-identified application are as follows: “roof coatings, acrylic coatings, elastomeric roof coatings, primers, acrylic silicone primers, sealants, elastomeric sealants, caulks, caulking”
11. As part of the Agreement, Applicant has agreed to delete “sealants, elastomeric sealants, caulks and caulking” from the identification of goods.

12. Accordingly, as part of the requested remand, Applicant also respectfully requests that the identified of goods for the above-identified application be amended to read: “roof coatings, acrylic coatings, elastomeric roof coatings, primers and acrylic silicone primers”. TBMP §1205.01
13. In compliance with 37 C.F.R. §2.142(d) and TBMP §1207.02, this Request for Remand is being filed prior to the rendering of any final decision by the Board in this Appeal, as well as prior to the filing of any briefs for this Appeal..

WHEREFORE, Applicant respectfully requests that this Motion be granted in its entirety resulting in the above-identified application being remanded back to the Examining Attorney to amend the identification of goods and to consider the Agreement in connection with the amended identification.

Respectfully submitted,

/Daniel S. Polley/
Daniel S. Polley, Reg. No. 34,902
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EXHIBIT A

CONSENT AND CO-EXISTENCE AGREEMENT

This Co-Existence Agreement ("Agreement") is made by and between Lapolla Industries, Inc. ("Lapolla"), with a business address of 15402 Vantage Parkway East, #322, Houston, Texas 77032 and Emseal Joint Systems Ltd. ("Emseal"), with a business address of 25 Bridle Lane, Westborough, Massachusetts 01581.

WHEREAS, Emseal has received a principal registration for the mark THERMAFLEX, U.S. Trademark Registration No. 2,814,821 ("the '821 Registration"), from the United States Patent & Trademark Office ("USPTO");

WHEREAS, EMSEAL has promoted and advertised its sealants for use in joints in structures and buildings ("Emseal Goods") under its THERMAFLEX mark, and that mark is used as a source indicator for the Emseal Goods;

WHEREAS, Lapolla has filed with the USPTO applications to register the trademarks THERMO-FLEX, U.S. Trademark Application Serial No. 77/626,768 ("the '768 Application") and THERM-O-FLEX, U.S. Trademark Application Serial No. 77/626,778 ("the '778 Application") (the '768 Application and the '778 Application will be collectively referred to as "the Lapolla Applications");

WHEREAS, the identification of goods for the Lapolla Applications list "roof coatings, acrylic coatings, elastomeric roof coatings, primers, acrylic silicone primers, sealants, elastomeric sealants, caulks, caulking" ("Lapolla Original Identification");

WHEREAS, the USPTO has denied registration of the Lapolla Applications asserting a likelihood of confusion under Trademark Act Section 2(d) with the mark THERMAFLEX, which is the subject of the '821 Registration;

WHEREAS, Lapolla has filed a Section 1068 Cancellation Proceeding No. 92/054,089 against the '821 Registration before the United States Trademark Trial and Appeal Board ("TTAB") ("the '089 Proceeding"); and

WHEREAS, the parties agree that their marks are not identical and that they offer distinguishable products and services under their respective marks to distinct customers and, therefore, the marks are not likely to be a source or subject of confusion and that neither party has ever experienced any actual confusion between the respective marks even with their co-existence in commerce for many years;

WHEREAS, both Lapolla and Emseal believe it is in their respective best interests to enter into an agreement and consequently, have negotiated this settlement, the terms, provisions, and conditions of which are fully set forth in this Agreement;

NOW, THEREFORE, for the mutual promises set forth in this Agreement and other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the parties state and agree as follows:

1. All of the preceding WHEREAS clauses are incorporated by reference in and made a part of this Agreement.

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2. Emseal does not object and will not object to or oppose and hereby consents to the registration of the THERMO-FLEX and THERM-O-FLEX marks by Lapolla in the U.S. for "Roof coatings, acrylic coatings, elastomeric roof coatings, primers and acrylic silicone primers" ("Lapolla Revised Identification").
3. Subject to the terms set forth herein, Emseal does not object and will not object to or oppose and hereby consents to the use of the THERMO-FLEX and THERM-O-FLEX marks by Lapolla in the U.S. for the goods listed in the Lapolla Original Identification except for sealants, elastomeric sealants, caulks and caulking marketed for use in connection with parking decks, stadiums and parking deck structures that provide for rooftop parking or that are not primarily intended for use with buildings. Subject to the terms set forth herein, Lapolla does not object and will not object to or oppose the use and registration of the THERMAFLEX mark by Emseal in connection with the Emseal Goods. With the successful use of this Agreement to remove the citation of the '821 Registration as a bar to registration of the Lapolla applications, Lapolla agrees to take no adverse action in the USPTO or in any U.S. Court against Emseal's '821 Registration and THERMAFLEX mark.
4. Lapolla agrees to delete "sealants, elastomeric sealants, caulks and caulking" from the identification of goods in the Lapolla Applications and agrees not to apply to register either of the marks contained in the Lapolla Applications or a confusingly similar mark thereto in the future for "sealants, elastomeric sealants, caulks and caulking."
5. Without constituting a waiver of any rights or defenses, Lapolla agrees not to use the marks contained in the Lapolla applications or any confusingly similar mark thereto in connection with "sealants, elastomeric sealants, caulks and caulking marketed for use with parking decks, stadiums and parking deck structures that provide for rooftop parking or that are not primarily intended for use with buildings". Lapolla also agrees not to promote or recommend its THERMO-FLEX and THERM-O-FLEX sealants and caulks for use with parking decks, stadiums and parking deck structures that provide for rooftop parking. Emseal agrees and acknowledges that any customer or purchaser's use of the THERMO-FLEX and/or THERM-O-FLEX sealants and/or caulks for parking decks, parking deck structures (as defined above) or stadiums is not a violation of the Agreement as long as Lapolla did not promote or recommend such use.
6. Without constituting a waiver of any rights or defenses, Emseal agrees not to use the THERMAFLEX mark or any confusingly similar mark thereto in connection with roof coatings, acrylic coatings and primers.
7. Within ten days of the execution of this Agreement, Lapolla will file a motion to dismiss the '089 Proceeding "without prejudice" and the Motion will affirmatively indicate Emseal's consent to the dismissal being "without prejudice" on the express condition that such dismissal will become "with prejudice" once the USPTO approves the Lapolla Applications for publication by issuing Notices of Publication. Once the USPTO approves the Lapolla Applications by issuing Notices of Publication, Lapolla agrees to file a motion to convert such dismissal to be "with prejudice" and to take any and all reasonable steps to effectuate this change. Lapolla further agrees that once the USPTO

issues Notices of Publication for the Lapolla applications. Lapolla will take no adverse action before the USPTO or in any U.S. proceeding against Emseal's '821 Registration and THERMAFLEX mark.

8. If the USPTO refuses to approve the Lapolla Applications for publication based on this Agreement, the parties agree to continue to negotiate in good faith changes to the Agreement that will address the examining attorney's concerns and overcome the continued refusals to register the THERMO-FLEX and THERM-O-FLEX marks. If the USPTO maintains the Section 2(d) refusal to register the THERMO-FLEX and THERM-O-FLEX marks, Lapolla shall have the right to file a new Section 1068 Cancellation proceeding against the '821 Registration. In that event, none of the terms contained herein shall be deemed to have waived any of Emseal's or Lapolla's claims or defenses, all of which are expressly reserved.
9. The parties note that neither is aware of any instance of actual confusion despite their concurrent use of their respective marks for many years and agree that no confusion as to source is likely from the continued use of the parties' respective marks in connection with their respective products identified above. The parties agree that they shall continue to cooperate to ensure that there is no likelihood of confusion between their above-identified respective marks. In the unlikely event that confusion among consumers occurs, the parties agree to take commercially reasonable steps to address and remedy such confusion.
10. The parties agree to take any further actions and execute any further agreements needed to carry out the spirit and intent of this Agreement, specifically taking any commercially reasonable steps necessary to help avoid confusion.
11. The parties agree that this Agreement and its terms and conditions shall be binding upon and inure to the benefit of the parties and their successors and assigns and all others acting by, through, or with them or under their direction or in privity with them.
12. This Agreement may be amended, modified, or supplemented only by written agreement executed by both of the parties to the Agreement.
13. In the event that any term or provision of this Agreement is held to be unenforceable by a court of competent jurisdiction, the remaining portions of this Agreement shall remain in full force and effect, and the invalid term or provision shall be replaced by such valid term or provision as comes closest to the intention underlying the invalid term or provision.
14. Each of the parties warrants and represents that it has the capacity and right to enter this Agreement; that this Agreement was fully negotiated by the parties and that none of the provisions of this Agreement are to be considered as having been drafted by either party; and that each party consents to the terms and conditions of this Agreement.
15. This Agreement comprises the entire agreement and understanding of the parties with respect to the subject matter of the Agreement. This Agreement supersedes

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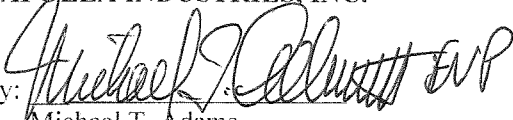
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all prior oral or written communications, agreements, or understandings between the parties with respect to the subject matter.

16. Nothing contained in this Agreement shall be construed as creating a joint venture, partnership, agency, or employment relationship between the parties.
17. Nothing contained in this Agreement shall be construed as an admission of wrongdoing or liability on the part of either party.
18. This Agreement may be executed in duplicate and delivered by facsimile or electronic mail, each of which shall be deemed an original, but both of which together shall constitute one and the same instrument.

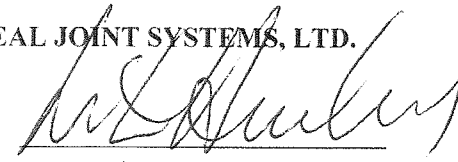
WHEREFORE the parties, by and through their authorized agents and representatives, hereby set their hand and seal to this Consent and Co-Existence Agreement effective as of the later of the dates of signature set forth below.

LAPOLLA INDUSTRIES, INC.

By: 
Michael T. Adams
Executive Vice President

Date: 8/21/13

EMSEAL JOINT SYSTEMS, LTD.

By: 
Printed Name: LESTER HENSLEY

Title: PRESIDENT

Date: August 16, 2013